



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,425	11/13/2003	Frank D. Lee	EPT-001C1	9956
51414	7590	12/06/2007		
GOODWIN PROCTER LLP PATENT ADMINISTRATOR EXCHANGE PLACE BOSTON, MA 02109-2881			EXAMINER LIN, JERRY	
			ART UNIT	PAPER NUMBER
			1631	
			MAIL DATE	DELIVERY MODE
			12/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/712,425	Applicant(s) LEE ET AL.	
	Examiner Jerry Lin	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-35, 126, 127 and 129-132 is/are pending in the application.
- 4a) Of the above claim(s) 11, 15 and 26-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14, 16-20, 22-25, 31-35, 126, 127, and 129-132 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

Continuation of Attachment(s) 6). Other: Petition Decision regarding color drawings.

DETAILED ACTION

1. Applicants' arguments, filed November 2, 2003, have been fully considered and they are persuasive. However, upon reconsideration of the claims, the following rejections are deemed necessary. They constitute the complete set presently being applied to the instant application.

Status of the Claims

Claims 1-10, 12-14, 16-20, 22-25, 31-35, 126, 127, and 129-132 are under examination.

Claims 11, 15, and 26-30 are withdrawn as being directed toward a nonelected invention. Election was made without traverse in the response filed June 9, 2006.

Drawings

2. The petition filed November 2, 2007 regarding the color drawings submitted October 5, 2007 has been granted. Please see attachment for the petition decision.

Claim Rejections - 35 USC § 112, 2nd Paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10, 12-14, 16-20, 22-25, 31-35, 126, 127, and 129-132 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly

point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: when the target protein is fragmented. Steps 1 and 2 consist of computational steps. Step 3 is drawn to generating a capture agent. Step 4 is drawn to subject a treatment to render the sample soluble in solution. Step 5 is drawn to detecting a post translational modification on a fragment. However, the claim does not recite creating any fragments from the sample. Applicant is advised that this rejection may be overcome by rewriting step 4 into three steps to include subjecting said sample to the treatment to create said fragments, rendering the fragments soluble in solution, and contacting the fragments with said capture agents; however, applicant is reminded that any amendment must be fully supported and enabled by the originally filed disclosure.

Claim 1 recites the limitation "said fragment bound to said capture agent" in step 5. There is insufficient antecedent basis for this limitation in the claim. While the claim does mention contacting a fragment to a capture agent, the instant claim does not previously recite that a fragment is bound to a capture agent.

Withdrawn Rejections

5. Applicant's arguments and amendments, filed November 2, 2007, with respect to the rejection made under 35 U.S.C. §112 1st paragraph as being not enabled to make or

Application/Control Number:
10/712,425
Art Unit: 1631

Page 4

use the invention commensurate in scope of the claims have been fully considered and are persuasive. This rejection has been withdrawn.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lin whose telephone number is (571) 272-2561. The examiner can normally be reached on 10:00-6:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie A. Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/712,425
Art Unit: 1631

Page 5

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JL/

/Marjorie A. Moran/
SPE, AU 1631
11/30/2007

Application/Control Number:

10/712,425

Art Unit: 1631

Drawings

The petition filed under 37 CFR 1.182 regarding color drawings is hereby granted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Supervisory Patent Examiner, Marjorie Moran, whose telephone number is 571-272-0720. The examiner can normally be reached on M-F 8:30 am- 3 pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marjorie Moran
Supervisory Primary Examiner
Art Unit 1631